

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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April 23, 2021

Opposition No. 91263510

Traxxas, L.P.

v.

Mattel, Inc.

Jill M. McCormack, Interlocutory Attorney:

On April 19, 2021, the Board held a telephone conference with the parties to address Opposer's motion to extend time to respond to discovery requests from Applicant.¹ (19 TTABVUE). The motion was fully-briefed. The participants in the conference were Gregory Carr and David Huang, attorneys for Opposer; Paul Bost, attorney for Applicant; and Jill McCormack, attorney for the Board.²

RELEVANT FACTS

On February 25, 2021, Applicant served Opposer with its First Set of Requests for Production, First Set of Interrogatories, and First Set of Requests for Admissions. (19 TTABVUE 2).

¹ Phone conferences may not be recorded. Trademark Rule 2.120(j)(3), 37 C.F.R. § 2.120(j)(3). The Board issues an order following the conference which becomes part of the record. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 502.06(a) (2020).

² The Board has considered all of the parties' arguments, presumes the parties' familiarity with the factual bases for their filings, and does not recount the facts or arguments here, except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

On March 24, 2021, Applicant filed a motion for leave to file an amended answer to add the affirmative defense of laches. (18 TTABVUE).

On March 26, 2021, counsel for Opposer sent counsel for Applicant an email requesting a first extension of time to respond to Applicant's discovery requests until April 12, 2021. (21 TTABVUE 21–22). In addition, counsel for Opposer suggested that the parties agree to a 30-day suspension of proceedings to engage in settlement negotiations. (*Id.*). Specifically, counsel for Opposer stated:

If the parties agree to suspend the proceeding, a 30-day suspension starting from Monday, March 29, 2021 would suspend the proceeding until April 28, 2021 and toll the running of the deadline for [Opposer] to respond to [Applicant's] discovery requests and the deadline for [Applicant] to produce documents as per [Applicant's] responses to [Opposer's] first set of discovery requests for the duration of the suspension period. Upon resumption of the proceeding on April 29, 2021, if settlement is not finalized or does not appear to be likely and the parties decide not to further extend the suspension, the requested two-week extension would extend the deadline for [Opposer's] response from the resumption date on April 29, 2021, to May 13, 2021.

(*Id.*). On March 29, 2021, counsel for Applicant responded to counsel for Opposer, agreeing to the first extension of time for Opposer to respond to the outstanding discovery requests and stating that it would “get back to [Opposer] regarding the suspension.” (*Id.* at 20).

On April 8, 2021, counsel for Opposer sent counsel for Applicant a follow-up email asking “whether [counsel] received a response from [Applicant] regarding the suspension of the proceeding while [Applicant] considers [Opposer's] counter [settlement] proposal.” (*Id.* at 15).

On April 12, 2021, counsel for Opposer sent counsel for Applicant another email stating, “[s]ince it appears more time is needed for your reply about the suspension,

please let us know (1) whether you will agree to extend the deadline for responses to the discovery requests by [Opposer] by an additional two weeks and (2) when we may expect a response concerning suspension of the proceedings.” (*Id.* at 19). That same day, counsel for Applicant responded that Applicant “is still considering [Opposer’s] request to suspend the proceedings,” and that Applicant “will agree to a final 10-day extension of time to respond to the discover requests provided [Opposer] stipulates to the filing of the amended answer.” (*Id.* at 17–18).

Later on April 12, 2021, Opposer filed its motion to extend time until April 26, 2021, to respond to Applicant’s discovery requests. (19 TTABVUE). Moreover, on April 13, 2021, Opposer filed its motion to extend time until April 23, 2021, to respond to Applicant’s motion for leave to file an amended answer. (20 TTABVUE).

LEGAL STANDARD

The standard for allowing an extension of a prescribed period prior to the expiration of that period is “good cause.” *See* Fed. R. Cir. P. 6(b). To show good cause, the moving party must set forth with particularity the facts allegedly constituting good cause and must demonstrate that the extension is not necessitated by the moving party’s own lack of diligence or unreasonable delay. *See Nat’l Football League v. DNH Mgmt. LLC*, 85 USPQ2d 1852, 1854 (TTAB 2008). “[T]he Board is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extension is not abused.” *Id.*

ANALYSIS AND DECISION

After review of the parties' submissions and the arguments made during the telephone conference, the Board finds that the short extension of time requested by Opposer is appropriate in this case. The Board finds no evidence of bad faith on the part of Opposer, and because this is Opposer's first unilateral request for an extension of time, Opposer has not abused the privilege of extensions. In addition, Applicant has indicated no specific prejudice to its ability to defend against Opposer's claims which would result from the requested extension.³ Accordingly, on this record, Opposer has made the requisite showing of good cause for an extension of time.

Although the mere existence of settlement negotiations, without more, generally will not justify a party's inaction or delay,⁴ in this case, on March 26, 2021, Opposer emailed Applicant proposing a 30-day suspension of the proceeding for potential settlement and specifically included a proposal for tolling the parties' respective discovery obligations during that time. On March 29, 2021, and again on April 12, 2021, Applicant notified Opposer that it was considering Opposer's proposal for such a suspension. While Applicant was under no obligation to agree to Opposer's proposed suspension, including the tolling of discovery response deadlines, Opposer was

³ Applicant's conditional consent to a 10-day extension of time undercuts any argument regarding prejudice.

⁴ In the absence of a suspension, the Board assumes the parties are working towards settlement simultaneously with doing the necessary work for discovery, trial, or any other pertinent deadlines. *See, e.g., Vital Pharms. Inc. v. Kronholm*, 99 USPQ2d 1708, 1711 (TTAB 2011); *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000); *Atlanta-Fulton Cty. Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859 (TTAB 1998).

entitled to know Applicant's position as to the requested suspension so that it could decide how to proceed.⁵

In view of the foregoing, and as stated during the call, Opposer's motion to extend time is **granted**. Opposer is allowed until April 26, 2021, to serve responses to Applicant's First Set of Requests for Production, First Set of Interrogatories, and First Set of Requests for Admissions.

In addition, during the call, Applicant consented to Opposer's motion, 20 TTABVUE, to extend time to respond to Applicant's motion for leave to file an amended answer, 18 TTABVUE. Accordingly, Opposer's motion to extend time to respond to the motion for leave is also **granted**. Opposer is allowed until April 23, 2021, to respond to the motion for leave to file an amended answer, failing which the motion may be granted as conceded. Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a).⁶

Proceedings are otherwise **suspended** pending disposition of Applicant's motion for leave to file an amended answer.⁷

⁵ Parties before the Board are under equal obligation to participate in good faith in efforts to resolve disputes, including as to scheduling. *Cf. Amazon Techs., Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007).

⁶ Applicant's reply, if any, must be filed in accordance with Trademark Rule 2.127(a).

⁷ This suspension order does not toll the time for the parties to respond to any outstanding discovery requests which had been served prior to the April 19, 2021 teleconference with the Board, including Opposer's responses to Applicant's First Set of Requests for Production, First Set of Interrogatories, and First Set of Requests for Admissions.